

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DENIS R.A. RIDYARD and ANDREW H.M. RENFREW

Appeal No. 1996-0740
Application No.08/107,146

ON BRIEF

Before KIMLIN, LIEBERMAN and KRATZ, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 2-6, 8, 9 and 14, all the claims remaining in the present application. A copy of illustrative claim 14 is appended to this decision.

Appeal No. 1996-0740
Application No. 08/107,146

Appeal No. 1996-0740
Application No. 08/107,146

The examiner relies upon the following references as evidence of obviousness:

Ciba Ltd. (Ciba) (patent specification)	1,003,786	Sep. 8, 1965
Benz et al. (Benz)	3,362,949	Jan. 9, 1968
Ackermann et al. (Ackermann)	3,697,500	Oct.10, 1972
Gerlach et al. (Gerlach)	3,988,310	Oct.26, 1976

Appellants' claimed invention is directed to a dye in accordance with the recited formula. According to appellants, the claimed dyes are novel and "are characterized by their good build up on cotton and their fastness to wet treatments and to light" (page 1 of Brief, 11/05/99). Also, we are told that [t]he dyes also have surprisingly high solubility in salt solutions" which "is of advantage in exhaust dyeing where such solutions are used" (page 1 of Brief, 11/5/99). Appealed claims 2-6, 8, 9 and 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ciba in combination with Benz or Gerlach or Ackermann.

We have thoroughly reviewed the respective positions advanced by appellants and the examiner, including the declaration evidence submitted by appellants. In so doing, we find that the prima facie case of obviousness established by the examiner has been rebutted by appellants' declaration

Appeal No. 1996-0740
Application No. 08/107,146

evidence of unexpected results. Accordingly, we will not sustain the examiner's rejection.

It does not appear that appellants dispute the examiner's determination that it would have been prima facie obvious for one of ordinary skill in the art to replace the hydroxy on the pyrazole moiety of Ciba with the claimed amino substituent in view of the teachings of the secondary references that the hydroxy and amino substituents are interchangeable on a pyrazole moiety of reactive dyes. Rather, it is appellants' contention that the Smith Declaration of October 16, 1992, the Brierley Declaration of October 21, 1992, the Ebenezer Declaration of September 23, 1993, the Butterworth Declaration of September 22, 1993 and the Ebenezer Declaration of August 21, 1995 establish unexpected results for the claimed dyes and, therefore, rebut the prima facie case of obviousness. In particular, the Brierley Declaration demonstrates that a dye of the present invention has far better build-up on cotton over a variety of concentrations and temperatures in comparison to a dye that is identical to the claimed dye with the exception of the presence of a hydroxy substituent instead of an amino substituent on the pyrazole moiety. Also, the Butterworth

Appeal No. 1996-0740
Application No. 08/107,146

Declaration compares a dye according to the present invention with a dye of Example 4 of Ciba, where the only difference is a hydroxy or amino substituent on the pyrazole moiety, and demonstrates that the dye of the present invention has better build-up when applied to cotton over a variety of concentrations, and surprisingly has much higher solubility in Glaubers salt solution. In addition, the Declaration of Dr. Ebenezer of August 21, 1995 states that the results of the the Brierley and Butterworth Declarations are surprising and unexpected.

In discounting the probative value of appellants' declaration evidence, the examiner offers that (1) the declarations are not commensurate in scope with the claimed subject matter, (2) all the compounds of the pertinent prior art have not been compared and (3) the comparison of two claimed compounds is insufficient to demonstrate that the claimed class of compounds, as a whole, would have the property demonstrated (see page 5 of Answer). In addition, the examiner offers that:

The differences in properties shown i.e. the difference are somewhat different but are not surprising or unexpected nor do any of the Declarants assert that the differences are

Appeal No. 1996-0740
Application No. 08/107,146

surprising or unexpected only that the results are better or superior which is not unexpected since compounds closely related structurally would not usually be expected to have exactly the same build-up or solubility." [Page 7 of Answer of 06/20/95].

In response to the Declaration of Dr. Ebenezer of August 21, 1995, the examiner set forth that "the new Ebenezer Declaration stating the differences are surprising and unexpected is not persuasive because in order to be persuasive the Declarants [sic, Declarant's] statements must bear out that the differences are really and truly surprising and unexpected. In this case the differences are not truly surprising and unexpected" (page 2 of Answer, 09/15/95).

For the reasons set forth by appellants in their principal and reply briefs, we find that appellants' declaration evidence is reasonably commensurate in scope with the degree of protection sought by the appealed claims, and represents a comparison with the closest prior art. Furthermore, in stating that "[i]n this case the differences are not truly surprising and unexpected" (page 2 of Answer, 09/15/95), the examiner has improperly substituted his opinion for the opinion of an expert in the art. In re Zeidler, 682 F.2d 961, 966-67, 215 USPQ 490, 494 (CCPA 1982).

Appeal No. 1996-0740
Application No. 08/107,146

In conclusion, based on the foregoing, it is our judgment that the evidence of nonobviousness presented by appellants outweighs the evidence of obviousness relied upon by the examiner. Accordingly, the examiner's decision rejecting the appealed claims is reversed.

REVERSED

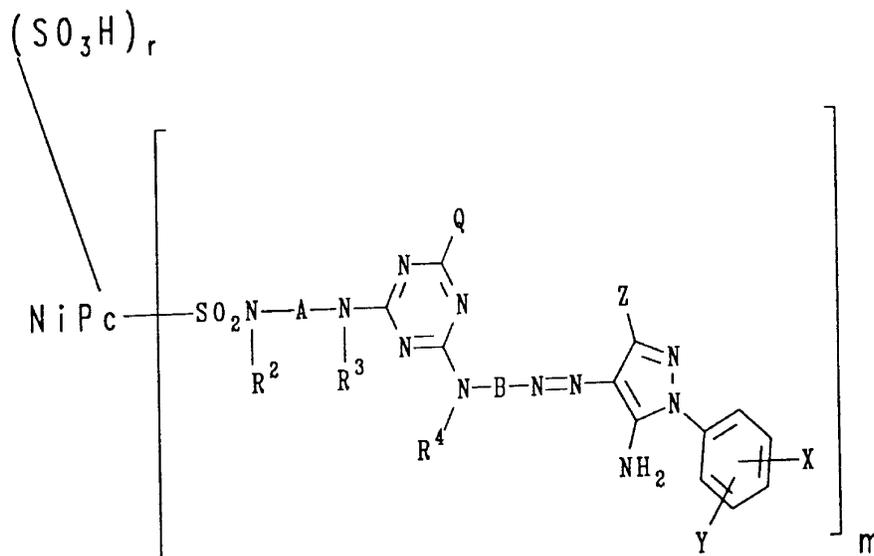
EDWARD C. KIMLIN)	
Administrative Patent Judge)	
)	
)	
)	
)	
)	
PAUL LIEBERMAN)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
)	
PETER F. KRATZ)	
Administrative Patent Judge)	

ECK:clm

Cushman, Darby & Cushman
Ninth Floor
1100 New York Ave., N.W.
Washington, DC 20005-3918

APPENDIX

14. A dye which, in the free acid form, is of the Formula:



wherein:

- | | |
|----------------------------------------------------|----------------------------------------------------------------------------------------------------------------------------------------------------------|
| NiPc | is a nickel phthalocyanine radical; |
| r | has a value from 1 to 3 inclusive; |
| m | has a value from 1 to 3 inclusive; |
| p | has a value from 0 to 1 inclusive; |
| R ² , R ³ and R ⁴ | are each independently H, C ₁₋₆ -alkyl or C ₁₋₆ -alkyl substituted by CH ₃ , OCH ₃ , halo, NO ₂ , |

Appeal No. 1996-0740
Application No. 08/107,146

CN, N₂COCH₃, NH₂, hydroxy, sulpho or
carboxy;

- A is phenylene, substituted phenylene,
C₁₋₆-alkylene or substituted C₁₋₆-alkylene,
wherein the substituent is selected from
CH₃, OCH₃, halo, NO₂, CN, N₂COCH₃, NH₂,
hydroxy, sulpho and carboxy;
- Q is halo, tri-(C₁₋₄)alkylammonium or a
pyridinium group;
- B is phenylene, phenylene substituted by 1 or
2 sulpho groups or phenylene substituted by
an alkyl or alkoxy group;
- Z is H or alkyl; and
- X and Y are each independently H, alkyl, alkoxy,
halogen, carboxy or sulpho;

provided that r+m does not exceed 4.